

PATENT

Customer No. 22,852

Attorney Docket No. 5049.0005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Ragnar TRYGGVASON et al.) Group Art Unit: 1797
)
Application No.: 10/552,629) Examiner: Benjamin M. Kurtz
)
Filed: October 7, 2005)
)
For: A FILTER FOR A CARTRIDGE, A) Confirmation No.: 8982
CARTRIDGE, USE OF A FILTER)
IN A CARTRIDGE AND A)
SYSTEM FOR PREPARING A)
LIQUID SOLUTION FOR A)
MEDICAL PROCEDURE)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated June 4, 2008, the Examiner required restriction under 35 U.S.C. § 121 between:

- Group I - Claims 1-60, allegedly drawn to a filter and to a cartridge;
- Group II - Claims 61-64, allegedly drawn to a use of a filter;
- Group III - Claims 65-69, allegedly drawn to a system for preparing a liquid solution for a medical procedure

Applicant provisionally elects, with traverse, to prosecute Group 1, claims 1-60, allegedly drawn to a filter and to a cartridge.

In the Office Action, the Examiner asserted that the inventions identified in Groups I -III "do not relate to a single general inventive concept under PCT Rule 13.1

because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The technical feature common to all of groups I-III is the filter as claimed in claim 1. The filter or claim one is not a special technical feature because it is known in the prior art to Kahana US 5 637 214. Because groups I-III lack a common special technical feature they do not relate to a single general inventive concept." (Office Action at 2.) Applicant respectfully disagrees. Under 37 C.F.R. § 1.475, which governs national stage applications, Groups I and II are one unitary invention. 37 C.F.R. § 1.475 states that:

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(Emphasis added.)

Accordingly, because the apparatus identified in Group I is a product and Groups II and III are a use and a system using the product of Group I, these groups of inventions have unity of invention and should be prosecuted in the same application. Thus, for at least this reason, Applicant respectfully asks the Examiner to withdraw the restriction requirement and to allow prosecution of Groups I-III in this application.

Moreover, Applicant disagrees that the prior art reference cited by the Examiner (U.S. Patent No. 5,637,214 to Kahana) does not disclose or suggests at least a filter for a cartridge having a particulate material as recited in the claimed invention. Rather, Kahana discloses a filter assembly adapted to be used in a water treatment apparatus for removing impurities from tap water. (Kahana, Abstract) Thus, for at least this reason, Groups I-III share a special technical feature that defines a contribution over the prior art.

Accordingly, for at least the reasons discussed above, Applicant respectfully requests that the Examiner withdraw the restriction requirement and allow Applicant to prosecute Groups I-III, including claims 1-69, in this application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: June 24, 2008

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